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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,544	09/17/2001	Gregory John Litster	57046-001US0	5670
22504 7590 04/14/2010 DAVIS WRIGHT TREMAINE, LLP/Seattle 1201 Third Avenue, Suite 2200 SEATTLE, WA 98101-3045			EXAMINER AKINTOLA, OLABODE	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 04/14/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/955,544

Applicant(s)

LITSTER ET AL.

Examiner

OLABODE AKINTOLA

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/15/2010 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (USPN 6282522) (Davis) in view of Kuo (USPN 6847953) and further in view of Mertens (USPAP 20020133468).

Re Claim 13-24: Davis teaches a method of making a financial transaction over the internet comprising: electing, by a purchaser, to pay for selected items from a merchant by credit card means using a virtual credit card terminal (VCT) comprising credit card means reader, a digital processing device operatively associated with said credit card means reader and encoding transaction programs that allows opening of an interactive terminal window for processing of the transaction, and wherein said virtual credit card terminal is registered with a VCT gateway (col. 7, lines 7-10, 44-46 and col. 11, lines 5-14); providing the purchaser with a transaction number from said VCT gateway (col. 13, lines 58-59), a merchant identification and an amount to transact from the merchant, wherein said merchant is registered with said VCT gateway (col. 13, lines 60-61); entering, by the purchaser, details of credit card means into the virtual credit card terminal to facilitate formation of a VCT transaction request (col. 14, lines 1-7); sending the VCT transaction request to said VCT gateway (col. 14, lines 1-7); providing, by said purchaser, the merchant with delivery details; and providing, by said merchant, said purchaser with a merchant receipt (col. 14, lines 62-65).

Davis does not explicitly teach processing the VCT transaction request by the VCT gateway to facilitate formation of a bank transaction request; sending the bank transaction request from the VCT gateway to a bank; processing the bank transaction request, whereby advice is sent from the bank to the VCT gateway as to whether the transaction has been approved; and sending the advice from the VCT gateway to the merchant and the purchaser; wherein if the transaction has been approved, providing the merchant and the purchaser with a transaction authentication code; Kuo teaches processing the VCT transaction request by the VCT gateway to facilitate formation

of a bank transaction request; sending the bank transaction request from the VCT gateway to a bank; processing the bank transaction request, whereby advice is sent from the bank to the VCT gateway as to whether the transaction has been approved; and sending the advice from the VCT gateway to the merchant and the purchaser (Fig. 1, col. 7, line 35 through col. 8, line 4).

Since each individual element (or combination of elements or steps) and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rest not on any individual element (or combination of elements or steps) or function but in the very combination itself- that is in the substitution of the teachings of Kuo for the teachings of Davies (batch transactions and acknowledgement). Thus, the simple substitution of one known element (or combination of elements or steps) or function for another producing a predictable results renders the claim obvious.

Mertens teaches the step of providing the merchant and the purchaser with a transaction authentication code if a transaction has been approved (paragraph 0013). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Davis to include this step. One would have been motivated to do so, so that the merchant can verify the authorization code provided by the purchase.

Response to Arguments

Applicant's arguments filed 3/15/2010 have been fully considered but they are not persuasive.

Applicant argues that KSR does not support an Examiner's arbitrary parsing of a plurality of elements from various respective asserted art references, while ignoring each of the inventions/references as a whole. Examiner respectfully disagrees with Applicant's assertion regarding the plurality of elements. Examiner notes that the Davis reference explicitly teaches that "in one embodiment of the invention the stored value card is implemented on a traditional credit card" (col. 7, lines 44-46 and col. 11, lines 5-14). While, Davis does not further disclose how this embodiment is fully implemented, one of ordinary skill in the art at the time of the invention would recognize that authorizing a traditional credit card transaction may be implemented using either batch processing technique or real-time processing technique as these techniques are old and well known. Support for this assertion can be found in *Yamada et al (US 4713760) at col. 9, lines 30-48 which teaches these alternative techniques*. Therefore, the rationale for the rejection, i.e., substitution of one known element for another to produce a predictable result is a valid rationale under KSR (See MPEP 2143 Rationale (B)). By incorporating this embodiment, Davis does not "teach away" from sending each transaction during a purchase; and modifying Davis to produce the device of claim 13 would not necessarily change the principle of operation taught by Davis.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed

invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Fox et al (USPN 5790677) disclose a system and method for secure electronic transaction (Figures).

b) Hughes et al (WO 96/04618) disclose a system for remote purchase payment and remote bill payment transactions.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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